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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/690,201	10/17/2000	Wail Refai	8194-458/P12483	2157

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EXAMINER

WILSON, ROBERT W

ART UNIT	PAPER NUMBER
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2661

DATE MAILED: 03/11/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/690,201

Applicant(s)

REFAI ET AL.

Examiner

Robert W Wilson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 17 October 2000.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-35 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-5, 9-13, 15-19, 21-25, 28, 29 and 31-34 is/are rejected.
- 7) ☒ Claim(s) 6, 14, 20, 26, 27 and 35 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 17 October 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

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***Detailed Action***

**1.0** The application of Refai et. al. entitled "METHODS, WIRELESS TERMINALS, AND SYSTEMS FOR ACQUIRING SERVICE USING STORED TDMA DIGITAL CONTROL CHANNEL INFORMATION" which was filed on 10/17/2000 without priority. Claims 1-35 are pending.

***Drawings***

**2.0** The drawings were reviewed by the draftsman and approved as formal.

***Specification***

**3.0** The specification is objected because the status of applications referred on Pg 10 lines 28-32 needs to be updated. Correction of the following is required: status of pending referenced application needs to be updated.

***Claim Rejections - 35 USC § 103***

**4.0** The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**Claims 1-5, 9-13, 15-19, 21-25, 28-29, 31-34** are rejected under 35 U.S.C. 103(a) as being unpatentable over Raith (U.S. Patent No.: 5,768,267).

Referring to **Claims 1 & 30**, Raith (U.S. Patent No.: 5,768,267) teaches the following limitations: TDMA (col. 1 lines 5-67); method & wireless terminal (col. 12 line 61-col. 14 line 21); camping on & means for camping on (col. 12 line 61-col. 14 line 21); request and means for request (mobile station activated or received a request per col. 12 line 61-col. 14 line 21); storing control channel info & means for storing control channel info (col. 12 line 61-col. 14 line 21); performing the requested operation to acquire a service as well as means (col. 12 line 61-col. 14 line 21)

Raith does not expressly call for: storing but teaches receiving neighbor list as well as PDCH assignment per col. 12 line 61-col. 14 line 21.

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It would have been obvious to one of ordinary skill in the art at the time of the invention that the mobile stores the neighbor lists or PDCH assignment in order for the invention to work.

**In Addition:**

Regarding **Claims 2 & 31**, control channel info # (upon activation an assigned DCCH with a # per col. 12 line 61-col. 14 line 21).

Regarding **Claims 3 & 32**, neighbor channel info # (neighbor lists which inherently contain channel # per col. 12 line 61-col 14 line 21).

Regarding **Claims 4 & 33**, receive a request (Activated or request per col. 12 line 61-col 14 line 21).

Regarding **Claims 5 & 34**, control channel info stored (It would have been obvious to one of ordinary skill in the art at the time of the invention that the control information is stored in order for the invention to work per col. 12 line 61-col. 14 line 21)

Regarding **Claim 9**, scanning (The examiner takes official notice that scanning is well known in the art per U.S. Patent No.: 6,414,945 per col. 12 line 61-col. 14 line 21)

Regarding **Claim 10**, scanning for synch (The examiner takes official notice that scanning is well known in the art per U.S. Patent No.: 6,414,945 per col. 12 line 61-col. 14 line 21. It would have been obvious to one of ordinary skill in the art at the time of the invention that the mobile must be synchronized in order to lock on.)

Referring to **Claim 11**, Raith (U.S. Patent No.: 5,768,267) teaches the following limitations: Method (col. 12 line 61-col 14 line 21); TDMA (col. 1 lines 5-67); receiving a first request (process neighbor lists or first request per col. 12 line 61-col 14 line 21); receiving a 2<sup>nd</sup> request mutually exclusive (Assigned a PDCH or second request per col. 12 line 61-col 14 line 21); performing (Assigned a neighbor list or first request and assigned PDCH or second request per col. 12 line 61-col 14 line 21)

Raith does not expressly call for: perform but teaches receiving neighbor list as well as PDCH assignment per col. 12 line 61-col 14 line 21.

It would have been obvious to one of ordinary skill in the art at the time of the invention that the mobile stores or performs the neighbor lists and PDCH assignment in order for the invention to work.

**In Addition:**

Regarding **Claim 12**, scanning (The examiner takes official notice that scanning is well known in the art per U.S. Patent No.: 6,414,945 per col. 2 line 67)

Regarding **Claim 13**, camping on (col. 12 line 61-col. 14 line 21)

Regarding **Claim 15**, store (180 per Fig 4. It would have been obvious to one of ordinary skill in the art at the time of the invention that the processing unit stores in order for the invention to work)

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Regarding **Claim 16**, second control channel (The examiner takes official notice that a second control channel is well known in the art per U.S. Patent No.; 5,953,665 per Abstract or col. 1 line 1-col. 5 line 17)

Regarding **Claim 17**, 2<sup>nd</sup> control channel and neighbor list (The examiner takes official notice that a second control channel receiving neighbor lists is well known in the art per U.S. Patent No.; 5,953,665 per Abstract or col. 1 line 1-col. 5 line 17)

Regarding **Claim 18**, media operation (The applicant broadly claims "media operation". The examiner interprets assigning a PCDH channel as a media operation because it is a packet channel per col. 12 line 61-col. 14 line 21)

Regarding **Claim 19**, send MP3 (It would have been obvious to one of ordinary skill in the art at the time of the invention to send MP3 over PCDH packet channel per col. 12 line 61-col. 14 line 21)

Referring to **Claim 21**, Raith (U.S. Patent No.: 5,768,267) teaches the following limitations: TDMA (col. 1 lines 5-67); wireless terminal (120 per Fig 4); housing (120 per Fig 4); transceiver (170 per Fig 4); antenna (120 per Fig 4); control circuit (180 per Fig 4) camping (col. 12 line 61-col. 14 line 21); stores (180 per Fig 4); performs mutually exclusive operations (180 per Fig 4 and col. 12 line 61-col. 14 line 21)  
Memory (180 per Fig 4)

Raith does not expressly call for: memory but teaches processing unit per Fig 4.

It would have been obvious to one of ordinary skill in the art at the time of the invention that the memory would be in the processing unit or controller in order to store data in order for the invention to work.

**In Addition:**

Regarding **Claim 22**, control channel info # (upon activation an assigned DCCH with a # per col. 12 line 61-col. 14 line 21).

Regarding **Claim 23**, neighbor channel info # (neighbor lists which inherently contain channel # per col. 12 line 61-col. 14 line 21).

Regarding **Claim 24**, receive a request (Activated or request per col. 12 line 61-col. 14 line 21).

Regarding **Claim 25**, control channel info stored (It would have been obvious to one of ordinary skill in the art at the time of the invention that the control information is stored in order for the invention to work per col. 12 line 61-col. 14 line 21)

Regarding **Claim 28**, scanning (The examiner takes official notice that scanning is well known in the art per U.S. Patent No.: 6,414,945 per col. 12 line 61-col. 14 line 21)

Regarding **Claim 29**, scanning for synch (The examiner takes official notice that scanning is well known in the art per U.S. Patent No.: 6,414,945 per col. 12 line 61-col. 14 line 21. It would have been obvious to one of ordinary skill in the art at the time of the invention that the mobile must be synchronized in order to lock on.)

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### ***Claim Objections***

**5.0**     **Claims 6, 14, 20, 26-27, & 35** are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The closest prior art is Raith (U.S. Patent No.: 5,768,267). Raith does not disclose either singularly or in combination anticipate the following claim limitations:

“wherein the operation to be performed comprises at least one of a voice activated dialing operation and a media playback operation” as claimed in **Claim 6**.

“wherein the first operation comprises performing a voice-activated dialing operation” as claimed in **Claim 14**,

“wherein the second operation to be performed comprises a radio frequency shutdown operation that disables radio frequency portions of the wireless terminal” as claimed in **Claim 20**.

“wherein an operation to be performed comprises at least one of a voice activated dialing operation and a media playback operation” as claimed in **Claim 26**.

“wherein a n operation to be performed comprises a transceiver shutdown operation that disables the transceiver circuit” as claimed in **Claim 27**.

“wherein the operation to be performed comprises at least one of a voice activated dialing operation and a media playback operation” as claimed in **Claim 35**.

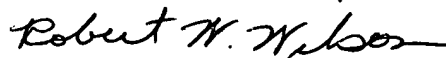
### ***Conclusions***

**6.0**     Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert W Wilson whose telephone number is 703/305-4102. The examiner can normally be reached on M-F (8:00-4:30).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Douglas Olms can be reached on (703) 305-4703. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Robert W Wilson  
Examiner  
Art Unit 2661

RWW  
February 19, 2004

